

REMARKS

The Examiner is thanked for helpful discussion during a telephone conference on December 9, 2004, during which the amendment to claim 35 and the need for a Terminal Disclaimer were discussed.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 29-31 and 34-36 are pending in this application. Claims 29-31 and 34 are allowed; claim 35 is amended.

Support for “nucleotides 286 to 466 of SEQ ID NO:6”, as recited in claim 35, can be found on page 4, lines 9-10, of the specification. No new matter is added by this amendment.

The claims, herewith and as originally presented, are patentably distinct over the prior art, and these claims are and were in full compliance with the requirements of 35 U.S.C. §112. The amendments of and additions to the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that the herewith amendments should not give rise to any estoppel, as the herewith amendments are not narrowing amendments.

Information Disclosure Statement

Enclosed is a copy of a Communication forwarding the Information Disclosure Statement that was filed in the parent of this application. The Communication was filed in this application on April 19, 2001. Applicant's representative has not received an initialed copy of the PTO Form 1449 that accompanied the IDS and requests that the Examiner please acknowledge entry and consideration of the cited references by returning an initialed copy of the 1449 to the undersigned.

II. THE REJECTION UNDER 35 U.S.C. § 112, 1ST PARAGRAPH, IS OVERCOME

Claim 35 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking adequate written description. This was a new matter rejection. The rejection is traversed.

Claim 35 has been amended to refer to nucleotides 286-466 of SEQ ID NO:6, rather than positions 286-487, as was previously recited. As discussed above, there is support for this recitation on page 4, lines 9-10, of the specification. The region of SEQ ID NO:6 between

nucleotides 286 and 466 corresponds to the juncture between the endogenous plant DNA and the 5' end of the foreign (inserted) DNA. A molecule comprising this sequence is useful in the detection of elite event GAT-ZM1 because only plant or plant part containing the elite event (*i.e.* with the foreign DNA inserted in a precise spot in the plant genome) would contain this sequence.

In view of the foregoing, reconsideration and withdrawal of the rejection under the first paragraph of Section 112 are requested.

III. THE REJECTION UNDER 35 U.S.C. § 102 IS OVERCOME

Claim 35 was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Brennan. The rejection is traversed.

Claim 35 was broadly interpreted to read on a nucleic acid molecule beginning with any nucleotide at positions 1-286 of SEQ ID NO:6 and ending with any nucleotide at positions 487-1041 of SEQ ID NO:6. That is obviously not Applicant's intention and the Examiner is thanked for her helpful suggestions in this regard. The amendment to claim 35 clarifies that the recited molecule should comprise a DNA sequence at the juncture of the endogenous DNA and the transgene.

Therefore, claim 35 cannot be anticipated by Brennan, as it does not teach elite event GAT-ZM1. Reconsideration and withdrawal of the Section 102 rejection are requested.

IV. THERE ARE NO DOUBLE PATENTING ISSUES


The Examiner indicated during the December 9, 2004 telephone conference that she would issue an obviousness-type double patenting rejection over the parent of this application, U.S. Patent No. 6,395,485. In an effort to expedite allowance and to avoid the necessity of a non-final Office Action, a Terminal Disclaimer to U.S. Patent No. 6,395,485 is enclosed.

CONCLUSION

Applicants believe that the application is in condition for allowance, and favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. If the Examiner would benefit from further clarification, she is invited and encouraged to contact the undersigned prior to the issuance of any further action.

Respectfully submitted,

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